

REMARKS

This Response is submitted in answer to the Office Action dated April 21, 2006, having a shortened statutory period set to expire on July 21, 2006, and in accordance with the telephone interview between Applicant and Examiner on May 19, 2006. Applicant notes with appreciation the courtesies extended by the Examiner in that telephone interview.

I. Claim Rejections under 35 U.S.C. §112, second paragraph

In paragraph 2 of the present Office Action, Claims 1-5, 7-9, 21 and 29 are rejected under 35 U.S.C. § 112, second paragraph, as indefinite. In particular, the Examiner believes "it is not clear how the feature of 'distributing a tracing tool to a first network element' is linked to 'monitoring traffic on, intercepting data of said communication between said electronic device and the second network element'"

In response, Applicant respectfully points out that the elliptical portion of the "monitoring" step of Claim 1 omitted in the Examiner's quotation explicitly states that the "monitoring" and hence the "intercepting" steps of Claim 1 are performed "utilizing said tracing tool." Because the "distributing", "monitoring" and "intercepting" steps of Claim 1 are linked by the common recitation of the "tracing tool", Applicant respectfully submits that Claim 1 is not indefinite and the rejection of Claim 1 and its dependent claims under 35 U.S.C. § 112, second paragraph, is overcome.

The Examiner also states in paragraph 2 of the present Office Action that the recitation of "at said data processing system" at line 9 of Claim 9 lacks antecedent basis and therefore renders Claim 9 unpatentable under 35 U.S.C. § 112, second paragraph. In response, Applicant has proposed an amendment to Claim 9 to delete the phrase "at said data processing system," thereby overcoming the § 112 rejection. Because the proposed amendment to Claim 9 does not raise any new issues and would not require any additional search or consideration, Applicant respectfully submits that entry of the proposed amendment is proper and requests entry of the proposed amendment to Claim 9.

II. Claim Rejections under 35 U.S.C. §102

In paragraph 4 of the present Office Action, Claims 1, 3, 7-9, 11, 24, and 26 are rejected under 35 U.S.C. § 102(b) as anticipated by U.S. Patent No. 5,638,423 to Grube et al. (*Grube*). That rejection is respectfully traversed, and favorable reconsideration of the claims is requested.

Applicant respectfully submits that exemplary Claim 1 is not rendered unpatentable by *Grube*, whether considered individually or in combination with *Cotichini* or *Gould*, because the references of record do not teach or suggest each feature of Claim 1. For example, *Grube* and the other references of record do not teach or suggest:

monitoring traffic on said wide area network utilizing said tracing tool, wherein said monitoring comprises intercepting data of said communication between said electronic device and said second network element including said identifying indicia ... (Claim 1, emphasis supplied).

In paragraph 4 of the present Office Action, *Grube's* proximity user card 115 and communication unit 102 are respectively cited as disclosing the "tracing tool" and "electronic device" recited in exemplary Claim 1. Utilizing this alignment between *Grube's* system and the claim elements, the Examiner asserts that *Grube* teaches:

monitoring traffic on the wide area network utilizing the tracing tool wherein the monitoring comprises intercepting data of the communication between the electronic device and the second network element including the identifying indicia in response to the physical separation (proximity message being set when a response is not received from proximity card and sent to central controller, see col. 3, lines 26-48)

Applicant respectfully disagrees.

Based upon the Examiner's mapping between *Grube's* system and the claim elements, the Examiner's §102 rejection of Claim 1 requires *Grube* to teach that proximity user card 115 performs the step of "intercepting data of the communication between [communication unit 102] and the second network element" as set forth in exemplary Claim 1. However, a careful review of *Grube* reveals that the reference contains no such teaching.

Instead, as agreed by Applicant and Examiner in the telephone conference of May 19, 2006, *Grube* discloses that proximity user card 115 communicates with communication unit 102 via RF communication path 119, but does not intercept any communication between communication unit 102 and a "second network element" such as communication resource allocator 101. Because *Grube* clearly fails to disclose proximity user card 115 intercepting any communication between communication unit 102 and a second network element as required by the Examiner's application of *Grube* to exemplary Claim 1, Applicant respectfully submits that the rejections of Claim 1, similar Claims 9 and 24, and their respective dependent claims are overcome.

Exemplary Claim 1 is also patentable over *Grube* because that reference does not teach or suggest "determining a physical position of said electronic device within said wide area network in response to an interception of said identifying indicia," as recited in Claim 1. As demonstrated above, *Grube* does not disclose proximity user card 115 intercepting communication between communication unit 102 and a second network device. Consequently, *Grube* cannot teach or suggest determining a physical position an electronic device (e.g., communication unit 102) "in response to an interception of said identifying indicia" as claimed. Because *Grube* does not disclose the determination of physical position as recited in exemplary Claim 1, Applicant respectfully submits that the rejections of Claim 1, similar Claims 9 and 24, and their respective dependent claims are overcome.

III. Claim Rejections under 35 U.S.C. §103

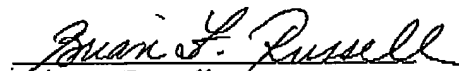
In paragraph 5 of the present Office Action, Claims 2, 4-5, 12, 21, 23, 25 and 27 are rejected under 35 U.S.C. § 103 as unpatentable over *Grube* in view of U.S. Patent No. 6,300,863 to Cotichini et al. (*Cotichini*). Finally, in paragraph 6 of the present Office Action, Claims 29-30 are rejected under 35 U.S.C. § 103 as unpatentable over *Grube* in view of U.S. Patent No. 6,756,917 to Gould et al. (*Gould*). All of the rejections under 35 U.S.C. § 103 are respectfully traversed for the reasons set forth above with respect to exemplary Claim 1.

IV. Conclusion

In light of the amendments and remarks made herein, Applicant submits that all pending claims are allowable and earnestly solicits notice thereof.

No extension of time for this amendment is believed to be necessary. However, in the event an extension of time is required, that extension of time is hereby requested. Please charge any fee associated with an extension of time as well as any other fee necessary to further the prosecution of this application and credit any overpayment to **IBM CORPORATION DEPOSIT ACCOUNT NO. 09-0447.**

Respectfully submitted,



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